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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,560	07/22/2003	Takashi Igari	240553US90	5905
22850	7590	08/30/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			BLACKWELL RUDASIL, GWENDOLYN A	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/623,560

Applicant(s)

IGARI ET AL.

Examiner

Gwendolyn Blackwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 13-24 is/are pending in the application.  
4a) Of the above claim(s) 5-8 and 13-24 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-4 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-4 in the reply filed on June 5, 2006 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

3. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 4 are indefinite as it is unclear whether the compounds set forth in claim 4 are further defining the compounds in claim 3 or whether the compounds in claim 4 are in addition to the compounds in claim 3. Applicant indicates in claim 3, line 2 that the film is comprised of at least one compound set forth in the grouping. In claim 4, the film comprises at least one compound set forth in the grouping. Applicant has not referred in claim 4 back to the group set forth in claim 3 to indicate that the compounds listed in claim 4 are further limiting the compound grouping of claim 3. Clarification is required. To further prosecution, the compounds in claim 4 will be considered as in addition to the compounds in claim 3.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

*(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent no. 6,391,948, Clark et al.

***Regarding claim 1***

Clark et al disclose a coating comprised of fluorochemical triazine compounds useful to the surface treatment of glass, (column 2, lines 47-65). The phrase “for m” is considered a statement of intended use. The intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Because the coated glass of Clark et al is not structurally different from the preformed glass material as claimed by Applicant, the preformed glass material as claimed does not provide patentable distinction over the prior art of record, meeting the limitations of claim 1.

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*Regarding claims 2-4*

Example 19 demonstrates a coating composition comprised of an organic compound containing fluorine, sulfur, and silicon, placed on glass rods, wherein the coating is comprised of the coating made according to Example 1 with the addition of titanium (column 18, lines 10-48; column 24, lines 45-62), meeting the limitations of claim 2.

Example 19 further has a surface energy of 16.4, (Table 1), meeting the limitations of claim 3.

Alkyl silane groups are preferred as a functional group to be used in the coating, which would result in an organic coating comprised of silicon and having a low surface energy, (column 4, lines 37-50; column 11, lines 36-39), meeting the limitations of claim 4.

6. Claims 1-3 are rejected under 35 U.S.C. 102(a) as being anticipated by United States Patent Application Publication no. 2003/0105263, Fan et al.

*Regarding claim 1*

Fan et al disclose a coating composition that can be applied to a glass substrate and used as a mold release coating wherein the coating forms bonds with the substrate, (page 13, sections 0155, 0157), meeting the limitations of claim 1.

*Regarding claims 2-3*

Example 1 demonstrates a coating comprised of an organic compound having at least fluorine, silicon, and nitrogen, (page 18, section 0253). As the coating of Example 1 contains compounds as set forth in Applicant's claim 3 that depends from claim 2, in addition to the fact that the coating has excellent low surface energy and can be used for mold release applications (page 13, sections 0157 and 0162), it would be expected that the coating would have a surface

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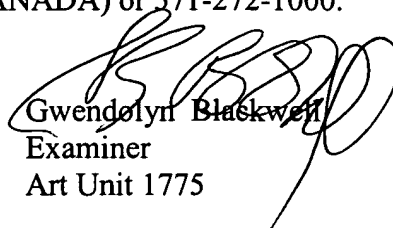
energy lower than  $60 \text{ mJ/m}^2$  absent an objective showing to the contrary, meeting the limitations of claim 2 and 3.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn Blackwell whose telephone number is (571) 272-1533. The examiner can normally be reached on Monday - Thursday; 6:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Gwendolyn Blackwell  
Examiner  
Art Unit 1775

gab